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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,427	03/31/2004	Paul Buchheit	060963-5008US	8813
24341 7590 01/22/2008 MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			EXAMINER MOUZON, LAJUANIA N	
			ART UNIT	PAPER NUMBER
			2153	
			MAIL DATE	DELIVERY MODE
			01/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,427

Applicant(s)

BUCHHEIT ET AL.

Examiner

La Juania N. Mouzon

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-40 is/are pending in the application.
- 4a) Of the above claim(s) 23-31 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/24/2005, 9/13/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to Applicant's Restriction Election, filed 12/21/2007, and Preliminary Amendment, filed 8/2/2004. Claims 15-22 and 32-37 are elected without traverse. Claims 23-31 and 38-40 are not elected. Claims 1-14 are canceled.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 9/13/2004 and 6/24/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "510" "606" "612" "680" "734" "736" "738" "741" "740" "743" "752" "750" "843" "1208" "1514" "1952". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because in figure 9B second spell check box would be labeled with number 823 instead of 832. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. Applicant's preliminary amendments to the specification filed on 8/2/2004, have been fully considered and are accepted.

6. The use of the trademark Google (§0054, last line) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

7. The disclosure is objected to because of the following informalities: in §00143 line(s) 3, the reference number with memory should be 1906 instead of 1006.

Appropriate correction is required.

8. The disclosure is objected to because of the following informalities: in §00152 line(s) 1, reference number 1095 should be 1952.

Appropriate correction is required.

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: defining of computer program product.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 32-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The broadest reasonable interpretation of "computer program product" which would be fairly conveyed to one of ordinary skill in the art is a "produced computer program." Therefore claims 32-37 are directed to the program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component realize it functionality. It's also clearly not directed to a composition of matter. Therefore, it's non-statutory under 35 USC 101.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 15-22 and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Moody et al. (US PGPub 2005/0144157).

13. In regards to claim 15 Moody et al. discloses, a method of searching conversations, comprising:

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- a. receiving a search query (**¶0056 line(s) 1-3 and ¶0057 line(s) 8-9**);
- b. identifying a conversation (**a message**) relevant to the search query, the conversation having one or more messages (**Fig. 5 #564**) sharing a common set of characteristics that meet predefined criteria and a respective conversation identifier (**¶0057 line(s) 10-14**); and
- c. returning the conversation as a search result to the search query (**¶0057 line(s) 21-24.**).

14. In regards to claims 16 and 33 Moody et al. discloses, wherein the identifying the conversation includes identifying a first message relevant to the search query (**¶0057 line(s) 10-14**).

15. In regards to claims 17 and 34 Moody et al. discloses, associating the first message to the conversation based at least in part on a subject of the message and information other than the subject of the message (**¶0053 line(s) 4-10, ¶0054 line(s) 6-9, and ¶0057 line(s) 10-14.**).

16. In regards to claims 18 and 35 Moody et al. discloses, associating the first message to the conversation based in part on information other than a normalized version of the subject of the message (**¶0053 line(s) 4-10 and ¶0057 line(s) 10-14.**).

17. In regards to claims 19 and 36 Moody et al. discloses, associating the first message to the conversation based at least in part on a subject of the message and

information other than one or both of a references field and an in-reply-to field (**¶0053 line(s) 4-10, ¶0054 line(s) 6-9, and ¶0057 line(s) 10-14.**).

18. In regards to claim 20 Moody et al. discloses, a method of searching messages, comprising:

- d. searching a message repository (**Fig. 1 # 110**) to identify one or more messages (**Fig. 5 #564**) relevant to a search query, wherein each identified message is associated with a respective conversation of a plurality of conversations (**Fig. 2 #224**), each conversation comprising one or more messages sharing a common set of characteristics that meet predefined criteria, and having a respective conversation identifier (**¶0057**);
- e. identifying the respective conversation identifiers of the conversations associated with the one or more identified messages (**¶0057 line(s) 10-18**);
- f. creating a list of one or more conversations, each of the conversations in the list corresponding to a respective identified conversation identifier (**¶0057 line(s) 10-21**); and
- g. producing at least a portion of the list of one or more conversations as the search result (**¶0057 line(s) 21-24**).

19. In regards to claim 21 Moody et al. discloses, associating the first message to the conversation based in part on information other than a subject of the message (**¶0053 line(s) 4-10 and ¶0057 line(s) 10-14.**).

20. In regards to claim 22 Moody et al. discloses, associating the first message to the conversation based in part on information other than a normalized version of the subject reference of the message (**¶0053 line(s) 4-6 and ¶0057 line(s) 10-14.**).

21. In regards to claim 32 Moody et al. discloses, a computer program product, for use with a computer system, the computer program product comprising:

- h. instructions for receiving a search query (**¶0056 line(s) 1-3 and ¶0057 line(s) 8-9**);
- i. instructions for identifying a conversation relevant to the search query, the conversation having one or more messages sharing a common set of characteristics that meet predefined criteria and a respective conversation identifier (**¶0057 line(s) 10-14**); and
- j. instructions for returning the conversation as a search result to the search query (**¶0057 line(s) 21-24**).

22. In regards to claim 37 Moody et al. discloses, a computer program product, for use in conjunction with a computer system, for searching messages, comprising:

- k. instructions for searching a message repository (**Fig. 1 # 110**) to identify one or more messages relevant to a search query, wherein each identified message is associated with a respective conversation of a plurality of conversations (**Fig. 2 #224**), each conversation comprising one or more messages and having a respective conversation identifier (**¶0057**);

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- l. instructions for identifying conversation identifiers of the conversations associated with the identified messages (**¶0057 line(s) 10-18**);
- m. instructions for creating a list of one or more conversations, each of the one or more conversations corresponding to a respective identified conversation identifier (**¶0057 line(s) 10-21**); and
- n. instructions for producing the list of conversations as the search result (**¶0057 line(s) 21-24**).

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hughes (US 6,892,196) system, method, and article of manufacture for a user programmable diary interface link.

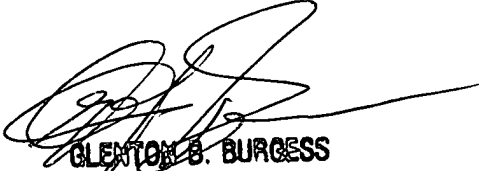
Any inquiry concerning this communication or earlier communications from the examiner should be directed to La Juania N. Mouzon whose telephone number is 571-270-3045. The examiner can normally be reached on Monday - Friday 8:00-5:00, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LNM



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